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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,132	01/20/2004	Raymond A. Liberatore	12 . 800	8784

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EXAMINER

ARYANPOUR, MITRA

ART UNIT PAPER NUMBER

3711

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,132

Applicant(s)

LIBERATORE, RAYMOND A.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-7,10-16,19,21-32,34-37 and 42-50 is/are pending in the application.
- 4a) Of the above claim(s) 48-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-7, 10-16, 19, 21-32, 34-37 and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 19 June 2006.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 48-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: because claims 48-50 are directed to a method for fabricating a swinging sport weighted practice implement. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 42 and 48-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: sleeve 200; 222 (see figure 23); 267 (see figure 30); 302 (see figure 32). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “202” has been used to designate both inner sleeve (see page 11, figure 23) and ring shaped retainer (see page 10, figure 20). Additionally, reference character “400” has been used to designate both sewn together (see page 13) and inner wall fabric (see page 13). Additionally, reference character “512” has been used to designate both outer fabric wall (see page 14) and donut (see page 14). Additionally, reference character “31” has been used to designate both annular retainer (see page 8) and conical retainer (see page 8). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. It is noted that the inner sleeve 202 should be changed to 220.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: frame members 270 (see page 12); foam 406 (see page 13); donut-shaped weight 500 (see page 14). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The use of the trademark SPANDEX or NEOPRENE has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. The disclosure is objected to because of the following informalities: on page 1, line 17, no clear meaning can be derived from "improvements as respects devices"; on page 6, line 15, "renewal" should be changed to "removal" after "lengthwise"; on page 7, line 1, "sleeve material" should be two words; on page 7, line 15, "continued" should be changed to "contained" after "granules"; on page 8, line 19, "40" should be changed to "40a", see figure 8); on page 10, line 11, it appears that either "width" or "diameter" should be inserted after "greater"; on page 12, line 10, "Figure" should be deleted after "Figures". Appropriate correction is required for the above objections.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 22 recites the limitation "a sleeve" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. The element "sleeve" has been recited in claim 12. Therefore, "a sleeve" should be changed to "the sleeve".

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 5-7, 10-16, 19, 21-30, 32, 34, 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Otten et al (6,533,685).

Regarding claims 1, 5-7, 10-16, 19, 21-25, 27-30, 32, 34 Otten et al discloses a bat weight and protector substantially as claimed. The device of Otten et al shows a sleeve (10) that

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extends about a bat, the sleeve includes retention means (30) and a annularly disposed weight (12) carried on the sleeve (see figures 1-3). As can be seen from the figures, the weight can be carried within an interior pocket formed from the combination of an outer layer and an inner layer. The sleeve and retention means are generally cylindrical in shape (see figure 1) and since a bat is generally tapered, the sleeve is also tapered. Otten et al also shows the sleeve includes a slit (the opening or slit formed between the straps). Otten et al further shows first and second means (40a-c or alternatively element 30 and the upper portion of the bat and weight protector 10, which is not identified with a reference character) for pulling the sleeve along the bat. It is clearly disclosed by Otten et al's that the device is to carry weight and to protect a bat, the device includes inner and outer surfaces for forming a pocket for retaining the weight (12) and the retention means (30) best seen in figure 2.

Regarding claim 26, during normal use and operation of the Otten et al device, the method steps set forth by applicant in the claim is inherently provided.

Regarding claims 35-37, see rejection of claims 1, 5-8, 10-16, 19, 21-25, 27-30, 32, 34.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans (4,000,893).

Regarding claim 1, Evans discloses an apparatus to add weight to an athletic ball-striking element having a sleeve, the sleeve associated with a retention means (hook and loop material) and annularly disposed weight means (16, 17) carried by the sleeve.

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Regarding claim 31, Evans further shows the sleeve includes flaps positioned along its length and end portions which are edge connected to form a reduced diameter sleeve section to closely fit about a hitting element (see figures 1-6).

13. Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Orchard et al (4,621,808).

Regarding claim 42, Orchard et al discloses a weighting device comprising a donut shaped member having an outer fabric casing, an inner fabric casing and being filled with a flowable material (see figures 1 and 2), the donut having an inner locus of engagement (the inner surface of the opening 16) and the weight material is spaced from the locus.

14. Claims 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Hart et al (5,980,397).

Regarding claim 43, Hart et al discloses a bat training weight substantially as claimed. The training weight of Hart et al shows a sleeve (weight device 1) that extends about a bat (2), the sleeve includes retention means (securing straps 9, 19, 20) and a annularly disposed weight (15 and 17) carried by the sleeve (see figures 2-3), and wherein the sleeve (1) includes at least one generally longitudinally extending expansion slit (see figures 1 and 2, the slits are not identified by a reference character).

Regarding claim 44, Hart et al discloses a bat training weight substantially as claimed. The training weight of Hart et al shows a sleeve (1) that extends about a bat (2), the sleeve having associated retention means (securing straps 9, 19, and 20); weight means (15, 17) carried by the sleeve; wherein the sleeve when in the deployed position is cylindrical in shape and

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wherein the retention means includes an annular retainer (the straps encircle the bat) which have inner surface for engaging the bat.

Regarding claim 45, Hart et al discloses a bat training weight substantially as claimed. The training weight of Hart et al shows a sleeve (1) that extends about a bat (2), the sleeve having associated retention means (securing straps 9, 19, and 20); weight means (15, 17) carried by the sleeve; and including an annular insert in the sleeve (the broadest reasonable interpretation of annular insert would include lower strap 20).

Regarding claim 46, Hart et al discloses a bat training weight substantially as claimed. The training weight of Hart et al shows a sleeve (1) that extends about a bat (2), the sleeve having associated retention means (securing straps 9, 19, and 20); weight means (15, 17) carried by the sleeve; and including an annular insert in the sleeve (the broadest reasonable interpretation of annular insert would include lower strap 20), and wherein the sleeve when in the deployed position is cylindrical in shape and wherein the retention means includes an annular retainer (the straps encircle the bat) which have inner surface for engaging the bat.

15. Claim 47 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hart et al (5,980,397).

Regarding claim 47, Hart et al discloses a bat training weight substantially as claimed. The training weight of Hart et al shows a receptacle (1) that extends about a bat (2), a retainer (any one of securing straps 9, 19, and 20); weighting structure (15, 17) carried by the receptacle; the retainer including a holder (the broadest reasonable interpretation of holder would include the D-rings 13 for receiving the straps and alternatively the hook-and-loop material placed on the straps); the retainer (straps 9, 19 and 20) including a coating (anti-slip coating 6). Although to

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explicitly thought, but it is inherently understood that the non-slip material used by Hart et al can be formed of rubber, since rubber is commonly recognized as a non-slip material and specifically used for the aforementioned purpose.

Response to Arguments

16. Applicant's arguments filed 18 June 2006 have been fully considered but they are not persuasive. The terminal disclaimer filed on 12 June 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 10/393,697 dated March 20, 2003 has been reviewed and is accepted. The terminal disclaimer has been recorded.

In a phone interview with Mr. Haefliger on 7 August 2006, the amended claims and the newly submitted claims were discussed. A summary of the discussion is incorporated under this Examiner's Response. It is the Examiner's position that the claims as amended still read on the art of record, namely the patent to Otten et al. The newly submitted claims read on the patent to Hart et al. Newly submitted claims 48-50 have been withdrawn from further consideration. These claims are directed towards a method of fabricating the weight device.

As indicated to Mr. Haefliger, the art which includes the inclusion of weight on athletic implements is pretty saturated. Applicant's claims as presented are too broad and mostly include functional language and very little structural limitation. As indicated above, the claims as presented easily read on the prior art of record. It appears that various structural elements some not claimed and others broadly claimed and presented in dependent claims can be incorporated in the base claims.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 10:00 to 6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

01 September 2006



MITRA ARYANPOUR
PRIMARY EXAMINER